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Section III: REMARKS

It is respectfully requested that the changes as noted above in Sections I and II be made to the present application.

In the above identified Office Action, the elected claims 1-25 and 33 were rejected. Applicant notes that non-elected claims 26-32 and 34 have been withdrawn from current consideration and applicant reserves the right to file a Divisional Application for consideration of the non-elected claims.

The drawings were objected to because they fail to show element 201 as described in the specification. As herein amended, the numeral "201" has been deleted from all three occurrences in the specification thereby obviating the Examiner's objection to the drawings. It is noted that the "application device" is shown in Figure 1 associated with the numeral "111", and that device is shown in its entirety and by itself in Figure 2 as described in the specification. Thus the inclusion of the numeral "201" in the specification is considered unnecessary and redundant and possibly even confusing and has therefore been deleted, thereby obviating the Examiner's objection to the drawings. The drawings are submitted to be in condition for acceptance and it is requested that the objection to the drawings be withdrawn.

Next in the Office Action, claim 1 was rejected under 35 USC 112, second paragraph, as failing to point out and distinctly claim the subject matter which applicant regards as the invention; claim 33 was rejected under 35 USC 101 as directed to non-statutory subject matter; claims 1, 3, 5-6, 11-13, 22 and 33 were rejected under 35 USC 102(a) as being anticipated by U.S. Patent Publication No. 2004/0054460 to Walters et al (herein referred to as "Walters"); claims 4, 8-10, 17-21 and 23-25 were rejected

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under 35 USC 103(a) as being unpatentable over Walters alone, claims 2-7 were rejected under 35 USC 103(a) as being unpatentable over Walters in further view of U.S. Patent No. 6,456,938 to Barnard (herein referred to as "Barnard"); and claims 14-16 were rejected under 35 USC 103(a) as being unpatentable over Walters in further view of Chapter 10, pages 395-401 of *Computing Concepts with JAVA 2 Essentials* (herein referred to as "Computing Concepts").

The above-noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claim in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended several of the claims to comply with the Examiner's objections and for clarification purposes only, to place all of the rejected claims in even better condition for allowance and/or appeal.

More specifically, in claim 1, applicant has included the step of "storing said GPS reading", as suggested by the Examiner, and claim 1 is now believed to be allowable under 35 USC 112, second paragraph.

Next, claim 33 has herein been amended to recite "a computer readable medium encoded with a computer program" as suggested by the Examiner and claim 33 is now believed to be allowable under 35 USC 101.

Next, with regard to the rejection of claims 1, 3, 5-6, 11-13, 22 and 33 under 35 USC 102(a) as being anticipated by Walters, it is noted that claims 1 and 33 are independent claims, and claims 2-

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25 are dependent claims ultimately depending from and including all of the limitations of claim 1 in addition to even further recitations contained in the dependent claims themselves. Applicant has herein amended independent claims 1 and 33 to clearly distinguish those claims from the Walters reference and therefore claims 1 and 33, as well as claims 2-25, are believed to be in condition for allowance over Walters.

More specifically, several of the claimed elements of claims 1 and 33 include "**determining** a desired **geometric shape** to be related to said GPS reading" and "**associating said geometric shape to said GPS reading for defining an area** having said geometric shape, said area having a selectable relationship to said GPS reading" (emphasis added). Simply stated, applicant is associating a GPS reading with a selected geometric shape. As shown by one of the examples in the specification, this may include acquiring a GPS reading for the center of the "Central Area 423", then selecting a circle ("selected geometric shape") with its center ("selectable relationship") located at the point of the GPS reading.

In rejecting the claims under 35 USC 102, on page 5 of the Office Action, although Walters does not disclose or teach the use of geometric shapes, the Examiner states that "it is highly likely that geometric shapes are generated by the mapping modules in the course of drawing maps" in Walters (emphasis added). It is submitted that it is improper to reject applicant's claims under 35 USC 102 on the basis of what the Examiner feels is "highly likely" without a specific showing of the claimed language in an applied reference. Applicant is unable to locate the "highly likely" language in the statute and to reject applicant's claims on the basis of what is felt to be "highly likely", without a proper showing in the applied art, is submitted to be highly

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improper. Applicant's claimed language is very clear and the fact is that nowhere does Walters teach or disclose (or even suggest) **"determining a desired geometric shape to be related to said GPS reading" and "associating said geometric shape to said GPS reading for defining an area having said geometric shape, said area having a selectable relationship to said GPS reading"** as claimed by applicant.

Further in rejecting claim 1, the Examiner refers to paragraph 32 of Walters which, for ease of reference, is reproduced below:

"The positioning modules provide navigation operations which interface to a positioning system associated with the device, and provide positioning information such as a present longitudinal coordinate, a present latitudinal coordinate, a present velocity, a present calendar data, and a present time of day. Furthermore in some embodiments, the positioning modules permit the association of a longitudinal coordinate to additional information such as, and by way of example only, a street address, a point-of-interest, a time label, or any other user-defined or custom application-defined label. In still more embodiments, the positioning modules provide satellite configurations, satellite identifications, satellite status, altitude data, depth data, and the like."

In the rejection of independent claims 1 and 33 under 35 USC 102, the Examiner alleges (page 5, 3rd line from the bottom of the page) that Walters anticipates the present invention as set forth in those claims and that "by associating a user-defined label that is a shape with a GPS reading, Walters would accomplish this result". That's like saying that if Walters did what the applicant does, Walters would accomplish the result accomplished by the applicant. It is respectfully submitted that that kind of circular logic does not provide a proper basis to reject applicant's own claims. The simple fact is that neither Walters

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nor any of the other applied references teaches or discloses (or even suggests) "**determining** a desired **geometric shape** to be related to said GPS reading" and "**associating said geometric shape to said GPS reading for defining an area** having said geometric shape, said area having a selectable relationship to said GPS reading" as is clearly set forth in applicant's independent claims 1 and 33.

It is noted that even the specific but comprehensive examples of what Walters himself means as "**labels**" are **only strings of alpha-numeric identification labels containing numbers and characters** in all instances. In the independent claims 1 and 33, the applicant specifically claims associating "**geometric shapes**" with "GPS readings". The difference is that identification "**labels**" are **strings of alpha-numeric characters** and "geometric shapes" are **area-defining boundaries**. By no stretch of the imagination can it be properly asserted that the two are equivalent or even remotely similar to, or suggestive of, each other.

Thus it is submitted that Walters does not even address, much less anticipate the combination recited by independent claims 1 and 33 as herein amended. Since dependent claims 3, 5-6, 11-13 and 22 depend from and include all of the limitations of amended independent claims 1 and 33, as well as even further limitations contained in the dependent claims themselves, it is submitted that all of claims 1, 3, 5-6, 11-13, 22 and 33 as herein amended are allowable under 35 USC 102(a) over Walters.

Next, claims 4, 8-10, 17-21 and 23-25 were rejected under 35 USC 103(a) as being unpatentable over Walters alone. It is noted that all of the above claims are dependent claims which ultimately depend from and include all of the limitations of independent claim 1. For the same reasons as stated above with respect to

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claims 1, 3, 5-6, 11-13, 22 and 33, it is submitted that claims 4, 8-10, 17-21 and 23-25, as herein amended, are allowable under 35 USC 103(a) over Walters alone since there is no disclosure or suggestion in Walters of "**determining a desired geometric shape to be related to said GPS reading**" and "**associating said geometric shape to said GPS reading for defining an area** having said geometric shape, said area having a selectable relationship to said GPS reading" as is clearly set forth in applicant's independent claim 1 from which claims 4, 8-10, 17-21 and 23-25 ultimately depend.

Next, with regard to the rejection of claims 2-7 under 35 USC 103(a) as being unpatentable over Walters in further view of U.S. Barnard, and claims 14-16 under 35 USC 103(a) as being unpatentable over Walters in further view of Chapter 10, pages 395-401 of Computing Concepts, it is noted that claims 2-7 and 14-16 are dependent claims which ultimately depend from and include all of the limitations of independent claim 1. Both Barnard and Computing Concepts are similar to Walters in that neither Barnard nor Computing Concepts discloses or suggests "**determining a desired geometric shape to be related to said GPS reading**" and "**associating said geometric shape to said GPS reading for defining an area** having said geometric shape, said area having a selectable relationship to said GPS reading". Thus it is submitted that even a combination of Walters and Barnard or Walters and Computing Concepts fails to render the present invention obvious under 35 USC 103 since none of the applied references suggests the total combination as claimed in claims 2-7 and 14-16. Thus it is submitted that claims 2-7 are allowable under 35 USC 103(a) over Walters in further view of U.S. Barnard, and that claims 14-16 are also allowable under 35 USC 103(a) over Walters in further view of Chapter 10, pages 395-401 of Computing Concepts.

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With general reference to all of the 35 USC 103 rejections, it is noted that applicant is not claiming that any of the individual elements of the claims as herein presented is new *per se*. Applicant is, however, claiming that the entire **combination of elements and relationships** among those elements as set out in the clear language of the claims as herein amended, is patentable. It is established that all inventions are, **and must be**, made up of known elements. However, the referencing of isolated elements in different contexts without any specific or stated suggestion of a beneficial combination or nexus cannot provide the basis to reject applicant's combination claims. Applicant is aware the individual elements of any claim can be isolated, and those elements, in different contexts, can be found in existing references. The similarity of various pieces and parts of the references as noted on pages 4-15 of the above-identified Office Action have been noted but it is believed that there is no suggestion or nexus in any of the references to even suggest any combination of those references or the total **combination of elements and relationships as recited in the claims as herein amended**.

Where there is no teaching or suggestion in any of the references for the specific total combination of elements and relationships among those elements, as claimed by an applicant, it is submitted to be inappropriate to search the prior art using applicant's own disclosure as a recipe, to find piecemeal elements in prior art references for individual claimed elements, and then to combine those references in a manner not disclosed or even suggested by any of the references in order to reject applicant's own claims.

In that connection, it is even further noted that, not only is there no suggestion in the references for the hypothetical combination of references, but any combination of references

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would render the individual references inoperable for its stated intended purpose thus confirming the absence of any possible suggestion for the proposed combination. Since the substitution of pieces of one reference for other pieces of another reference would destroy each for its intended purpose, it is unsupportable and illogical to allege that a combination of the two references is obvious to one of ordinary skill in the art, or that the combination is suggested by any of the references.

Therefore, as herein amended, Claims 1-25 and 33 are submitted to be in condition for allowance an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for claim language changes for expediting the allowance of this application, and especially if one or more new references are cited, the Examiner is invited to contact the undersigned at the telephone number indicated below, prior to the issuance of another Office Action, in order to allow the applicant the opportunity to further amend the claims by Supplemental Amendment or Examiner's Amendment, as may be appropriate, to place the claims in condition for allowance. The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

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